

REMARKS

Claims 1-49, 55, 57-61, 64-68, 73 and 77-92 are pending. By this Amendment, claims 60 and 61 have been amended, and claims 85-90 have been added. In addition, a Request for Approval of Drawing Corrections is presented herein which requests approval for corrections to marked-up Figs. 2 and 3, attached hereto.

Claims 1-49, 55, 57-61, 64-68, 73, and 76-84 were rejected under 35 U.S.C. §112, first paragraph. Claim 76 was canceled in the September 24, 2001 Amendment. Otherwise, this rejection is respectfully traversed.

Attached hereto is a Request for Approval of Drawing Corrections to make Figures 2 and 3 more consistent with the proposed correction to Figure 4 filed on September 24, 2001. Previously, the Examiner approved the removal of the 90° steering positions in Figure 4. This obviously exaggerated position shown in Figure 4 was provided for the purposes of illustration so that the reader could easily see that the rider's knees do not interfere with turning of the steering device or handle bars. After elimination of the 90° position, what is left is the more realistic and actual turning radius of the steering device, e.g., the handle bars.

Applicants propose to amend Figures 2 and 3, for consistency with Figure 4, by repositioning the windshield to allow movement of the steering device as shown in Figure 4. Approval of the proposed corrections is respectfully requested since they are basically the same as the drawing corrections filed on June 22, 2000 and approved by Examiner Boehler. Other changes are being made to the drawings which have already been approved. Also see, e.g., *In re Oda*, 170 USPQ 268, 272 (CCPA 1971) (one skilled in the art would appreciate not only the existence of an error in the specification, but what the error is. As a corollary, it follows that when the nature of this error is known, it is also known how to correct it).

Moreover, none of the claims requires "handle bars". Rather, the "steering device" encompasses an entire class of steering devices, inclusive of 1) a steering wheel, 2) the handlebars illustrated in the application Figures or 3) a yolk of the type used in aircraft. See page 9, last full paragraph. Accordingly, even if an embodiment with handle bars is not enabled by the present specification, which it is, embodiments with a steering wheel or an aircraft-type yolk are enabled because they would not interfere with the windshield. (In the January 22 Office Action, the Examiner has not commented on any reasons why a "steering wheel" is not operative. See page 11.)

Finally, assuming for the purposes of argument that the examiner is correct in that the handlebars interfere with the windshield, that argument only applies to claims reciting both a steering device (e.g., handlebars) and a windshield. Only two of the claims (57 and 58) specify both. Figure 4 shows an embodiment (without the windshield) where the handlebars are clearly rotatable to steer the front skis. Therefore, the rejection of at least claims 1-49, 59-61, 64-68, 73 and 77-84, none of which specifies both a steering device and a windshield, is clearly in error and should be withdrawn. For some of the remaining claims, e.g., claims 59 and 60, which were not rejected under §101 (discussed immediately below), a notice of allowability is respectfully requested in the event the examiner agrees the claims distinguish over Preble, as discussed further below.

Withdrawal of the rejection is respectfully requested.

Claims 1-49, 55, 57, 58, 61, 64-68, 73 and 76-84 were rejected under 35 U.S.C. §101. Claim 76 was canceled on September 24, 2001. Otherwise, this rejection is respectfully traversed.

All the claims in this application are directed to a snowmobile including, for example, a frame, an engine, a drive track, skis, a seat and for a steering device. This is statutory

subject matter under 35 U.S.C. §101. Moreover, the various elements of the snowmobiles are defined in terms of how they are arranged so that a rider may assume a certain position – the rider is not claimed. For example, claim 1 specifies a straddle seat disposed on the frame behind the engine, and a seat dimensioned to support a standard rider with a center of gravity in a standing position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain.

Thus, claim 1 does not claim "a rider positioned on the snowmobile," but a seat dimensioned to support a standard rider. This is an important distinction. To make it even more clear that Applicants do not claim a rider, claim 87, which is similar to claim 1, has been added herein. Claim 87 specifies: "wherein the snowmobile has a first center of gravity without the rider, and wherein the snowmobile is adapted to have a second center of gravity with the rider in the standard position such that, in use, a distance...between the first and second centers of gravity is between 0-14 cm". (Underlining shows changes as compared with claim 1.) If claim 87 is deemed acceptable by the Examiner, other claims can be amended in similar fashion upon request.

Further, claim 84 does not specify a "rider." Rather, claim 84 specifies a "load."

The Office Action also errs when it states on page 9 that "the dimensions of the vehicle have been omitted." A review of the specification and drawings reveals that an incredible amount of detail is provided regarding dimensions, angles, etc. of the snowmobile. See, e.g., the many angles shown in Figures 2, 3, 5, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17 and 18 and the corresponding descriptions thereof, and the dimensions (between various portions of the snowmobile seat, steering device and footrest) shown in Figures 2, 6, 11 and the corresponding descriptions thereof. Also, Figures 19 and 20 provide every possible human

parameter that could conceivably be necessary to make a snowmobile according to what is claimed.

Further, the statement on p. 9 of the Office Action that “the examiner does not see exactly the dimensions provided with respect to the rider would be projected onto the vehicle, particularly since the dimensions of the vehicle have been omitted” is inconsistent with the other statement in the Office Action (p. 2) that “[t]he difference between the two snowmobiles (the prior art one and that of applicant (sic)) is the position of the handlebars.” One aspect of the present invention is just that – moving the position of the steering device more toward the front of the snowmobile – in amounts detailed in the specification and various claims – as compared to the position of the steering device of the prior art. Because the basic architecture between the snowmobiles of Figures 1 and 2 is very similar, and the differences between the positions of the steering devices and footrests, e.g., are provided in the specification and set forth in various claims, one of ordinary skill in the art would have the knowledge of how to construct the claimed snowmobile.

Also, the Office Action also states that “it would be impossible to determine the scope of the claim based on a rider”. See page 3. This statement is not understood in the context of §101. Is the examiner saying that the claims are indefinite? If so, a rejection under §101 is improper. Instead, the rejection should be under §112, second paragraph. That rejection is addressed below. In any event, the claims effectively set forth, for example, a seat that is dimensioned to support a standard rider, which is defined in the specification. Thus, for purposes of determining infringement, the test for this element is whether the accused device has a seat that is dimensioned to support the defined standard rider. Infringement does not require a rider – a rider is not required for infringement. The scope of the claim is clear.

Further on page 3, the Examiner states that the seat position is "defined by the user, his weight and measurements at any given time, and where he chooses to position his body while riding the vehicle." It is not clear what claim or claims the examiner is referring to. However, one claim reciting the "seat position" is claim 40. However, claim 40 recites " ... wherein, for the standard rider in the standard position, the seat defines a seat position...". Again, the seat, not the rider, defines the seat position. Further, the Examiner is obviously continuing to ignore that claim 40, for example, recites "a seat ... dimensioned to support a standard rider in a standard position ...". The standard rider is defined as the 50-percentile human male, and the standard position is defined as well. Thus, contrary to the statement in the Office Action, it is not the rider's weight "at any given time" or where he "chooses" to position his body while riding the vehicle. The test for infringement is whether the snowmobile components are dimensioned to support the standard rider in the standard riding position, as claimed.

It is clear that the claims are being rejected under §101 simply because the Examiner has no prior art or because she does not prefer Applicants' chosen language. However, see MPEP §2173.02 ("Examiners. . . . should not reject claims or insist on their own preferences if other modes of expression selected by Applicants satisfy the statutory requirement.") Applicants are entitled to claim a snowmobile with structure (e.g., footrests, seat and steering device) that enables a unique or advantageous position for the rider.

Finally, contrary to the statement on page 10 of the Office Action, case law was cited to show that it is proper to claim an apparatus as a function of the rider. See Ex Parte Brummer, 12 USPQ 1853, 1655 (Bd. App. 1989) (claim drawn to a bicycle having a wheel base defined as a function of the height of the rider that the bicycle was designed for – rejected under 35 U.S.C. §112(2), not §101, because there was no evidence that there is a

known standard for sizing a bicycle to a rider)) and Banyan Licensing L.C. v. Allied Foam & Packing, 2000 WL 1671797 (N.D. Ohio, 2000) (upholding validity of claim under 35 U.S.C. §112 for a claim drawn to a pillow having a longitudinal axis "no less [in length] than that of a human thigh). See also U.S. Patent No. 5,355,826 (defining a snowmobile in terms of the rider's positioning on the snowmobile), U.S. Patent No. 3,913,929 ("the center of gravity of said cycle with the rider in said support means, lies below said plane" (claim 1)), other patents mentioned on page 25 of Applicants' January 12, 2001 Amendment, and the 70-80 patents issued by Examiner Anne Marie Boehler (e.g., U.S. Patent No. 5,501,476 (portions reproduced on page 26 of the January 12, 2001 Amendment)) that define an apparatus in terms of a rider, user, operator or a person. If the Examiner persists in this rejection, she is respectfully requested to explain her different treatment of the claims from this application as compared to her treatment of the claims from her issued patents.

For these reasons, and for those outlined the Amendment filed on January 12, 2001, withdrawal of the rejection is respectfully requested.

Claims 1-49, 55, 57, 58, 61, 64-68, 73 and 76-84 were rejected under 35 U.S.C. §112, second paragraph. Claim 76 was canceled on September 24, 2001. This rejection is respectfully traversed.

In the Office Action, it is stated that "Applicant (sic) has failed to specify the weight of the rider". See page 4. Contrary to that statement, each independent claim (as of the September 24, 2001 Amendment) dealing with a standard rider has been further defined to specify that the standard rider has dimensions and weight of a 50-percentile human male. The weight and dimensions of a 50-percentile human male are provided with an incredible amount of detail in Figs. 19 and 20. In addition, see page 9, second full paragraph of the original and amended specification.

The Office Action also states that "a rider, a human being, cannot be standardized, no matter how many dimensions are specified, ..." See p. 8-9. This statement demonstrates, in a nut shell, just how unreasonable the rejection is. Apparently, Applicants cannot add anything that will convince the Examiner to withdraw this rejection. Certainly, this cannot be the case. All that is required is that one of ordinary skill in the art be able to practice the claimed invention without undue experimentation. The current specification allows this. There is no requirement that Applicants provide a blue print and step-by-step instructions in the claims.

Accordingly, the scope of each of the claims can be determined with an incredible amount of detail with respect to the standard rider. For purposes of measuring infringement, it is the 50-percentile human male that forms the basis whether or not infringement occurs. Stiffness of the joints and age of the rider are irrelevant compared to what Applicants claim. For example, the age and stiffness of the joints of a rider will not affect where the center of gravity of the rider is located assuming that rider is positioned in the standard position and has the specified dimensions and weight of the 50-percentile human male. The posture of the standard rider is that shown in the drawings, for example. See also claim 40 (the rider's torso is tilted forward the steering device and the rider's arms extend forward the steering device with the rider's elbows substantially over the rider's feet").

That is not to say that a snowmobile with a non-standard rider cannot infringe Applicants' claims. For determining infringement of Applicants' claims, one need only place a 50-percentile human male on any given snowmobile and measure the rider's positioning against what is recited in the claims.

Withdrawal of the rejection is respectfully requested.

Claims 40, 41, 45-49, 76, and 81-84 were rejected under 35 U.S.C. §102(b)/§103(a) over Yasui et al. Claim 76 was canceled in the September 24, 2001 Amendment. This rejection is respectfully traversed.

At the outset, Applicants' appreciate that the rejection of claims 44 and 73 has been withdrawn. (New claim 90 is similar to claim 44, but does not include the standard rider or position or other language regarding the angles.) In fact, it is of some significance that the basis of the rejection was changed from §102(b) alone to §102(b)/103(a). Further, the Examiner states that "it is unclear whether Yasui anticipates the claimed invention because the claims are believed to be indefinite." This seems to be an admission that the claims are not anticipated. In any event, there are no aspects which have been raised by the Examiner which cast doubt on the definiteness of the claims, as explained above. The standard rider's dimensions and weight are claimed. The standard position of the rider is claimed. Claims (e.g., claim 40) also include elements of the rider's posture. The only elements which are not claimed and that are raised in the rejection relate to the age and flexibility of the rider, which are irrelevant. Even if these factors are necessary, it is unclear how the absence of these factors from the claims, which are not necessary to clearly set forth what Applicants regard as their invention, make it impossible to determine whether Yasui anticipates the claims. Finally, there is no statement of obviousness – why is it obvious to modify Yasui, and in what way or ways does the Examiner propose to modify Yasui?

Yasui does not teach at least the following features, and it would not have been obvious to have modified Yasui to have done so, without the use of impermissible hindsight based on Applicants' own disclosure.

First, Yasui does not teach a seat dimensioned to support a standard rider (50th percentile human male) in a standard position, as claimed. Yasui is a small sized snow

vehicle (it's not even a snowmobile according to Yamaha, who makes the Yasui "SNOSCOOT", it is a snow "vehicle"). See the "Snowmobile Business" article filed on March 12, 2001 – the SNOSCOOT is of "small size".

Second, because it has a small size, Yasui does not provide for a tunnel, which is typically provided for full sized snowmobiles. See "Snowmobile Business" – describing the SNOSCOOT as lacking a tunnel as such, because of its small size. New claims 85 and 88 have been added to recite aspects of the disclosed snowmobile in relation to the tunnel. Figures 5-18 of the present specification show the tunnel. Claim 85 is similar to claim 59, which is not rejected on art, and claim 88 is similar to claim 40 but includes a tunnel to more clearly distinguish over Yasui.

Third, because the portrayed rider in Yasui is in a cramped position, the steering device is disposed such that the rider's torso is substantially erect, rather than being tilted toward the steering device, as claimed. Also, Yasui's steering device is disposed such that the elbows are substantially over the seating position, rather than substantially over the rider's feet. Yasui's snowmobile is miniaturized in size and its seat, steering position and footrests are not designed, dimensioned and configured with respect to one another such that the rider assumes the position specified in claim 40.

Fourth, even assuming that the rider could slide back in Yasui to arrive at the subject matter of claim 40, the Yasui rider would not longer be positioned in the standard riding position, as claimed. Yasui's standard riding position is that position shown in Fig. 1. For example, if Yasui's rider were to slide rearwardly on the seat, the rider would no longer be able to move his or her leg between the starter and the footrest, as shown in Fig. 1. In other words, sliding of the Yasui rider rearwardly of the Yasui seat might arguably meet some features of the claims but other features of the claims would no longer be satisfied.

Moreover, the Yasui snowmobile would not have the seat, footrest and handle bars that are positioned as specified in Applicants' claims.

Fifth, Yasui clearly does not teach or disclose the subject matter of claim 84, which is similar to claim 1, which was not rejected. It is believed that this rejection is an error.

Withdrawal of the rejection is respectfully requested.

Claims 42 and 43 were rejected under 35 U.S.C. §103(a) over Yasui. These claims depend from claim 40 and are patentable by virtue of that dependency. In addition, Applicants take exception with the Examiner's assertion that it would have been obvious for a rider who was taller than the rider shown to sit farther back in the seat. Claim 40 specifies a standard rider, and that standard rider is a 50-percentile human male. Thus, claims 42 and 43 also relate to the 50-percentile standard male and the subject matter of these claims cannot be met by changing the size of the rider. Also, claims 42 and 43 cannot be met by moving the rider because claim 40 specifies a standard position. Assuming Yasui teaches a standard position, claims 42 and 43 cannot be rendered obvious by moving the rider from that standard position. The January 22, 2002 Office Action does not address these points.

Withdrawal of the rejection of claims 42 and 43 is respectfully requested.

Claim 55 was rejected under 35 U.S.C. §103(a) over Marier. This rejection is respectfully traversed.

Claim 55 recites a snowmobile including a frame, a seat and a steering device, two skis and a windshield. A line between the steering position and the seat position forms an angle μ with a line between the seat and the top of the windshield that lies between 10 and 20°.

Applicants appreciate that the Examiner has retreated from her position that Marier teaches an angle between 10 and 20°, as evidenced by the change in basis of the rejection

from 35 U.S.C. §102(b) to 103(a). However, there is no reason to increase Marier's angle to meet Applicants' claim, absent the use of impermissible hindsight. There is no valid reason to raise Marier's windshield to meet claim 55. The claimed range of 10-20° is advantageous, given that the standard rider is in a new standard position, as defined in the claim, since, e.g., the claimed relationship between the top of the windshield and the seat position allows the rider to avoid turbulent air flow and instead allows the head of the rider to be positioned with the laminar flow, which is more comfortable. The Examiner has not shown that there is any benefit to raising the windshield as taught by Marier.

Withdrawal of the rejection is respectfully requested.

Claims 60 and 61 were rejected under 35 U.S.C. §102(b) over Preble. This rejection is respectfully traversed.

Preble does not teach that the forward-most axle is positioned forward of the center gravity and rearward of a rearward-most portion of the steering device such that the center of gravity is rearward of the rearward-most portion of the steering device. It is clear from reviewing each of the figures that Preble's forward-most axle is positioned forward of the steering device, not rearward, as claimed in claims 60 and 61. Further, Preble does not teach a steering device that is positioned forward of both the center of gravity and the forward-most drive axle, as recited in new claim 89.

Withdrawal of the rejection is respectfully requested.

Claim 73 was rejected under 35 U.S.C. §103(a) over Trautwein. This rejection is respectfully traversed.

Claim 73 specifies that the forward portion of each sideboard is disposed at an angle horizontal that is -5°. Trautwein does not teach this subject matter in any Figure. The significance of this feature is described on page 10, last paragraph through page 11, third full

paragraph. See also new claim 86. In addition, Trautwein does not teach that left and right toe holds are disposed respectfully above the rider's toes in a vertical plane for allowing the rider to releasably secure himself to the snowmobile. Trautwein discloses nothing for holding the toes in place – no structure is provided above the rider's toes in a vertical plane, as claimed.

Withdrawal of the rejection is respectfully requested.

New claims 85, 86 and 92 patentably distinguish over the prior art of record, without recitation of a standard rider, a standard position or a steering device. Thus, none of the rejections in the Office Action apply to these new claims, and a notice that at least these claims are allowable is respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are patentable and that the entire application is in condition for allowance.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached Appendix is captioned **“Version with markings to show changes made”**.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Pillsbury Winthrop LLP

By: _____

Paul T. Bowen

Registration No.: 38,009

Tel. No.: (703) 905-2020

Fax No.: (703) 905-2500

PTB/jck

Enclosures:

Appendix

Request for Approval of Drawing Corrections

1600 Tysons Boulevard

McLean, VA 22102

(703) 905-2000

APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE SPECIFICATION:

Page 9, first full paragraph, please delete this paragraph in its entirety and replace it with the following:

A drive track 120, which is operatively connected to the engine, is positioned below frame 114. Drive track 120 is a continuous belt that runs around a number of axles including a forward-most axle 121 that is obscured by fairings 122 in FIG. 2 (but is illustrated in FIGS. 5-18). Forward-most axle 121 of snowmobile 110 is at or near the center of gravity 144 of snowmobile 110 with the rider, as would be understood by those skilled in the art. Further details in this respect are provided in connection with the discussion that accompanies FIGS. 5-18. FIGS. 5-18 show that portion of the frame 114 which is commonly referred to in the snowmobile art as a tunnel.

IN THE CLAIMS:

Please amend claims 60 and 61, as follows:

60. (Four Times Amended) A snowmobile, comprising:
- a frame having a forward-most drive track axle disposed thereon;
 - a straddle seat disposed on the frame;
 - an engine disposed on the frame in front of the seat;
 - two skis disposed on the frame; and
 - a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile;

wherein the snowmobile has a center of gravity without a rider and the steering device is disposed on the frame forward of the center of gravity, and wherein the forward-most axle is positioned forward of the center of gravity and rearward of a rearward-most portion of the steering device such that the center of gravity is rearward of the rearward-most portion of the steering device.

61. (Four Times Amended) A snowmobile, comprising:

a frame having a forward-most drive axle mounted thereon;

a straddle seat disposed on the frame, the seat being dimensioned to support a standard rider in a standard position in which the standard rider straddles the seat while the snowmobile is heading straight ahead on flat terrain, the standard rider having dimensions and weight of a 50-percentile human male;

an engine disposed on the frame in front of the seat;

two skis disposed on the frame; and

a steering device disposed on the frame and operatively connected to the two skis for steering the snowmobile;

wherein the snowmobile [has] is adapted to have a center of gravity with a rider in the standard position [and] such that the steering device and the forward-most drive axle are disposed on the frame forward of the center of gravity, and such that the forward-most drive axle is positioned rearward of a rearward-most portion of the steering device so that the center of gravity is rearward of the rearward-most portion of the steering device.

New claims 85-92 are added.